



#7
W. Lawson
1/19/01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Grauch et al.

SERIAL NO.: 09/496,825

GROUP ART UNIT: 2711

FILED: February 1, 2000

EXAMINER: C. Grant

FOR: CUSTOMER USAGE
TRACKING SYSTEM

RECEIVED
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TECH CENTER 2100

ATTORNEY DOCKET NO.:
BS95007/086082

Assistant Commissioner for
Patents
Washington, D.C. 20231

DECLARATION OF EDWARD ROWLAND GRAUCH UNDER 37 CFR § 1.131(a)

1. My name is Edward Rowland Grauch. I am over the age of 21 and I am competent to make the declaration based upon my personal knowledge. I understand that this declaration will be used in the United States Patent and Trademark Office ("Patent Office") in connection with the above-identified pending patent application. I also understand that this declaration is being submitted by the owner of the above-referenced application in order to show that the invention claimed in certain claims of that patent application was conceived and reduced to practice in the United States before the November 7, 1995 filing date of U.S. Patent No. 5,778,182 to Cathey et al. I understand that the Patent Office contends this patent to be relevant to at least claims 1-7 of the above-referenced application.

2. I am presently Vice President, Systems of Livewire Incorporated. Through Livewire Incorporated, I presently provide consulting services to BellSouth Entertainment, which I understand is affiliated with the BellSouth entity that presently owns the above-referenced application. In order to prepare this declaration, I have reviewed: my work files relating to the development of the invention, for the above referenced patent claims 1-7 of the application, the Cathey et al. patent, § 715.07 from the Manual of Patent Examining Procedure that describes the issues of conception, diligence, and reduction to practice, and 37 C.F.R. §1.31. In addition, I have spent approximately 26 hours in preparing this declaration and locating support exhibits, for which my company Livewire, Inc. is being compensated at my normal hourly consulting rate of \$ 110.⁰⁰ per hour. Based upon my personal knowledge, I declare the following:

3. I am a co-inventor of claims 1 through 7 of the patent application identified-above and inventor of the subject matter described and claimed therein. Based on at least the following facts, I believe that my co-inventors and I conceived the Invention at least as early as August 18, 1995.

(1) I worked on the subject matter of claims 1 through 7 of the above-identified application ("the Invention"), in the United States, on behalf of BellSouth Corporation ("BellSouth"). In my employment with BellSouth, I was in charge of system development of

the Invention and was involved with the implementation of the Invention via and in the Navigator software.

(2) At least as early as August 18, 1995, my co-inventors and I at BellSouth had conceived the Invention in the United States.

(3) Exhibit 1 is a draft version 1.30, dated August 18, 1995, of the design specifications of the Invention, at least some aspects of which we referred to as the "Clickstream system." A copy of this document was filed by BellSouth's counsel as a disclosure document with the U.S. Patent Office on August 19, 1996. Although the disclosure document was filed on August 19, 1996, the filed document itself is clearly dated August 18, 1995. I personally prepared the document on that date, as indicated by the initials "TG," which stand for Ted Grauch.

4. Beginning at least as early as August 18, 1995 through December 6, 1996 and based on at least the following facts, I and others worked diligently toward actually implementing or "reducing to practice" the Invention.

(1) Exhibit 2 comprises photocopies of actual invoices, dated August 24, 1995 through October 20, 1996, submitted by my employer, Livewire, Inc., to BellSouth for my services rendered to BellSouth, while working on the Invention. Throughout this time period, I worked toward implementing, or "reducing to practice," the invention in the United States. As part of that effort, and as described in the work detail of the invoices, I worked on

the platform for the BellSouth Digital Broadcast System (BDBS) platform. The BDBS platform was the particular platform by which BellSouth chose to offer the Invention to the public. The BDBS offers digital broadcast television to subscribers. The Invention allows interactive customer use on the BDBS to be tracked to provide knowledge about subscriber usage of the BDBS. Thus, in order to bring this particular implementation of the Invention to actual practice, I necessarily also focused my time and effort in getting the BDBS operational and integrating the Invention with the BDBS.

(2) Exhibit 3 is a document that I completed on April 22, 1996, in the United States. Exhibit 3 summarizes the anticipated system components and resulting capabilities of the Invention. The document explains the operation of the Invention and the anticipated impact of the Invention on the BDBS.

(3) Exhibit 4 is a document that I completed on June 4, 1996, in the United States, presenting a project plan for the Invention. The plan details various tasks to be completed by others and myself who were working toward implementing the invention.

(4) Exhibit 5 is a document that I participated in drafting, in the United States. Exhibit 5 was completed in September 1996, and it defined test procedures necessary to study the impact of the Invention after it was deployed on the BDBS.

(5) Exhibit 6 is a test summary report for the Navigator 3.2 software that comprised one way of implementing the Invention. The testing results, obtained from a

confidential test performed in the United States, completed on December 1, 1996, proved that the Invention had passed quality assurance tests and was ready for release in the market.

(6) Exhibit 7 is a document showing the product release history, in the United States, of BDBS including the Invention. The Invention was first introduced in the Navigator release on November 21, 1996. The Navigator version then deployed was soon thereafter removed in favor of Navigator version 3.22, which successfully implemented the Invention. This version, 3.22, was released and deployed as part of the trial on December 6, 1996.

C. Exhibits attached hereto are photocopies of original documents.

D. I believe that the attached exhibits show that I and the other inventors had conceived the Invention at least as early as August 15, 1995, and, from that date to December 6, 1996, the exhibits show that I and others diligently worked on actually reducing to practice the subject matter of claims 1-7. One version of the invention was actually reduced to practice at least as early as December 6, 1996 with the deployment of Navigator version 3.22.

4. As the person signing below, I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under

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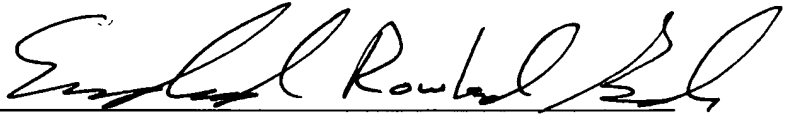
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§ 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, or any patent issued thereon.

Dated:

July 12, 2000



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